

BEST AVAILABLE COPY

Appl. No. 09/780,804
Amdt. Dated May 10, 2006
Reply to Office Action of January 20, 2006

Attorney Docket No. 2048-089 (81841.0183)
Customer No.: 26021

REMARKS/ARGUMENTS:

Claims 1, 2, 4-10, and 21-30 are pending in the application. Reexamination and reconsideration of the application, in view of the following remarks, are respectfully requested.

INTERVIEW SUMMARY:

On April 11, 2006, Patent Agent Barry Shuman conducted a telephone interview with Examiner Dwayne K. Handy. During the interview the parties discussed the Final Office Action dated January 20, 2006. Specifically, the rejection over Pottorff was discussed. No agreement was reached regarding this rejection. Examiner Dwayne Handy suggested that the Agent discuss this rejection further with his Supervisor Jill Warden.

On April 19, 2006, Patent Agent Barry Shuman conducted a second telephone interview with the Examiner's Supervisor Jill Warden. During the interview the parties discussed the Final Office Action dated January 20, 2006, and specifically, the rejection over Pottorff. Supervisor Jill Warden agreed with the Agent's position that the claims, as written, were patentable over Pottorff.

The Applicant would like to thank Examiner Dwayne Handy and the Examiner's Supervisor Jill Warden for the courtesy of granting telephone interviews with Patent Agent Barry Shuman on April 11, 2006 and April 19, 2006, respectively.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102:

Claims 1, 2, 4, 21, 22, and 24 stand rejected under 35 U.S.C. 102(e) as being anticipated by Pottorff (U.S. Patent No. 6,148,710). The Applicant respectfully traverses this rejection.

Appl. No. 09/780,804 Attorney Docket No. 2048-039 (81841.0183)
Amdt. Dated May 10, 2006 Customer No.: 26021
Reply to Office Action of January 20, 2006

Claim 1 is as follows:

An apparatus for piercing container caps, comprising:

- a) a piercing blade having a longitudinal axis and a zigzagged cross-section that is perpendicular to said axis;
 - b) an alignment arm for moving said blade in a linear motion along said longitudinal axis to pierce a cap on a container, comprising a carriage assembly for moving said alignment arm, wherein movement of said blade is limited to linear motion along said longitudinal axis, wherein said zig-zagged cross-section produces a Z-shaped cut on said cap; and
- means for driving said carriage assembly.

Pottorff cannot anticipate claim 1 because Pottorff fails to teach that the zig-zagged cross-section produces a Z-shaped cut on a cap.

Pottorff cannot render claim 1 obvious because Pottorff fails to teach or suggest that the zig-zagged cross-section produces a Z-shaped cut on a cap. On the contrary, the hole punch of Pottorff has a hollow circular barrel portion and a ring of triangular cutting teeth at its bottom end. (Pottorff, column 3, lines 40-41). Consequently, when the hole punch enters a cap, a circular shape is formed. In the present invention, the Z-shaped pattern continues along the longitudinal axis of the blade. It is an aspect of the present invention that the Z-shaped cut pattern made by the Z-shaped blade vents better for improved clot detection and sample aspiration. The Z-shaped blade of the present invention cuts through the tube caps more easily and with less stretching of the elastomer, resulting in more consistent cut size and better venting. (Applicant's specification, at page 9, lines 3-6).

Appl. No. 09/780,804 Attorney Docket No. 2048-039 (81841.0183)
Amdt. Dated May 10, 2006 Customer No.: 26021
Reply to Office Action of January 20, 2006

It is a further aspect of the present invention that the lubed piercing blade with a Z-shaped cross-section can reduce the amount of vertical force required to pierce a thick cap or stopper, which prevents jamming the cap or stopper into the sample container, and also reduces the retraction force required to strip the cap or stopper from the piercing blades. The Z-shaped cut made by the new blades allows adequate ventilation during sample probe entry, so that obstruction detection and sample aspiration meet the system requirements. (Applicant's specification, at page 8, lines 27-33).

In light of the foregoing, Applicant respectfully submits that Pottorff could not have anticipated or rendered obvious claim 1, because Pottorff fails to teach or suggest each and every claim limitation. Claims 2 and 4 depend from claim 1 and cannot be anticipated or rendered obvious for at least the same reasons as claim 1. Withdrawal of these rejections is thus respectfully requested.

Claims 21, 22, and 24, likewise, have the limitation that the zig-zagged cross-section produces a Z-shaped cut on a cap. Therefore, these claims are patentable over Pottorff for the same reasons discussed above. Withdrawal of these rejections is thus respectfully requested.

ALLOWABLE SUBJECT MATTER:

Claims 5-10 and 25-30 are allowed.

Appl. No. 09/780,804

Attorney Docket No. 2048-039 (81841.0183)

Amdt. Dated May 10, 2006

Customer No.: 26021

Reply to Office Action of January 20, 2006

The Examiner objected to claim 23 as being dependent upon a rejected base claim, but states that this claim "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." The Applicant respectfully submits that since claim 23 depends from claim 21 and this claim is believed to be patentable, claim 23 is believed to be patentable in its current form. Withdrawal of this objection is thus respectfully requested.

Applicant believes the foregoing remarks comply with requirements of form and thus may be admitted under 37 C.F.R. § 1.116(b). In addition, admission is requested under 37 C.F.R. § 1.116(b) as presenting rejected claims in better form for consideration on appeal.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, in view of the foregoing, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (310) 785-4674 to discuss the steps necessary for placing the application in condition for allowance.

Appl. No. 09/780,804
Amdt. Dated May 10, 2006
Reply to Office Action of January 20, 2006

Attorney Docket No. 2048-039 (81841.0183)
Customer No.: 26021


If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,

HOGAN & HARTSON L.L.P.

Date May 10, 2006

By:


Wei-Ning Yang (contact person)

Registration No. 38,690

Attorney for Applicants

Barry M. Shuman

Registration No. 50,220

500 South Grand Avenue, Suite 1900
Los Angeles, California 90071
Phone: 213-337-6700
Fax 213-337-6701